

REMARKS

Reconsideration of this application is respectfully requested in view of the foregoing amendment and the following remarks. By the foregoing amendment, claims 1, 7, and 8 have been amended. No new matter has been added. Claim 2 is withdrawn from consideration. Thus, claims 1 and 3-9 are currently pending in the application and subject to examination.

In the Office Action mailed October 6, 2005, the Examiner objected to Claims 7 and 8 for informalities. Claims 7 and 8 have been amended responsive to this rejection, following the suggestion of the Examiner. If any additional amendment is necessary to overcome this rejection, the Examiner is requested to contact the Applicants' undersigned representative.

The Examiner rejected Claims 1-9 under 35 U.S.C. § 112 second paragraph, as being indefinite. Claims 1 and 8 have been amended responsive to this rejection. If any additional amendment is necessary to overcome this rejection, the Examiner is requested to contact the Applicant's undersigned representative.

The Examiner rejected Claims 6-8 under 35 U.S.C. § 112, first paragraph for lack of enablement. The Examiner rejected Claims 1 and 5 under 35 U.S.C. § 102(b) as allegedly being anticipated over Peters et al. (U.S. Patent No. 6,435,465), hereinafter "Peters", Claims 6-8 under 35 U.S.C. § 103(a) as allegedly being unpatentable over Peters in view of Kuang et al. (U.S. Patent No. 6,590,299), hereinafter "Kuang", and Claims 3-4 under 35 U.S.C. § 103(a) as allegedly being unpatentable over Peters in view of Wakashiro et al. (U.S. Patent No. 6,886,649), hereinafter "Wakashiro". To the

extent that the rejections remain applicable to the claims currently pending, the Applicant hereby traverses the rejection, as follows.

I. Rejection of Claims 6-8 Under 35 U.S.C. § 112, First Paragraph

The Examiner rejected Claims 6-8 as failing to comply with the enablement requirement because “the disclosure . . . sets forth no apparatus, process or method whereby the vehicle can determine the angle of inclination of a road surface.” The Applicants respectfully traverse this rejection. Enclosed is an Information Disclosure Statement having a copy of U.S. Patent No. 6,033,041 issued to Koga et al. on March 3, 2000 and a copy of U.S. Patent No. 5,807,205 issued to Odaka et al. on September 15, 1998 which was readily available at the time of the invention which describes a conventional apparatus, process, or method whereby a vehicle may determine the angle of inclination of a road surface. Consequently, the invention as claimed is sufficiently enabled.

II. Rejection of Claims 1 and 5 Under 35 U.S.C. §102(b)

Applicants submit that Peters does not describe or suggest at least the limitation of the primary motor rotating the engine according to driving conditions of the vehicle while combustion within cylinders in the engine is suspended. Instead, Peters appears to teach the engine where “the ignition system . . . continue[s] firing the spark plugs during the time periods that the fuel injectors are being disabled and the engine is being spun by the electric motor”. (See Peters Column 2 Lines 19-33). This is done to reduce emissions from the vehicle. (See Peters Column 2 Lines 47-49). The vehicle in Peters does not suspend combustion while the engine is spun by a motor.

For at least this reason, Applicants submit that claim 1, as amended, is allowable over the cited prior art. As claim 1, is allowable, Applicants submit that claims 2-9, which depend from allowable claim 1, are likewise allowable over the cited prior art.

III. Rejection of Claims 3-4 Under 35 U.S.C. § 103(a)

In addition to the arguments above for the Peters reference, the Applicants assert that under 35 U.S.C. § 103(c), Wakashiro does not qualify as prior art under 35 U.S.C. § 103(a). Wakashiro is used as a § 102(e) reference and along with the present application, was at the time the invention was made, subject to an obligation of assignment to the same person. Both Wakashiro and the current application are subject to an obligation of assignment to Honda Giken Kogyo Kabushiki Kaisha. According to 35 U.S.C. § 103(c), Wakashiro is not a proper reference to be used in a §103(a) rejection for the present application.

IV. Rejection of Claims 6-8 Under 35 U.S.C. § 103(a)

Claims 6-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Peters in view of Kuang. As discussed above for claim 1, from which claims 6-8 depend, the Peters reference does not describe or suggest at least the limitation of the primary motor rotating the engine according to driving conditions of the vehicle while combustion within cylinders in the engine is suspended. Kuang does not cure this deficiency. Therefore, neither Peter nor Kuang describe or suggest at least the limitation of the primary motor rotating the engine according to driving conditions of the vehicle while combustion within cylinders in the engine is suspended. For at least this reason, claims 6-8 are allowable over the cited prior art.

CONCLUSION

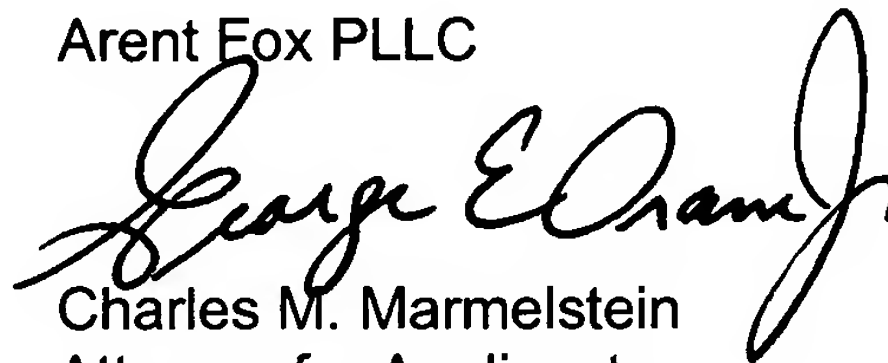
For all of the above reasons, it is respectfully submitted that the claims now pending patentability distinguish the present invention from the cited references. Accordingly, reconsideration and withdrawal of the outstanding rejections and an issuance of a Notice of Allowance are earnestly solicited.

Should the Examiner determine that any further action is necessary to place this application into better form, the Examiner is encouraged to telephone the undersigned representative at the number listed below.

In the event this paper is not considered to be timely filed, the Applicants hereby petition for an appropriate extension of time. The fee for this extension may be charged to our Deposit Account No. 01-2300. The Commissioner is hereby authorized to charge any fee deficiency or credit any overpayment associated with this communication to Deposit Account No. 01-2300.

Respectfully submitted,

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Enclosure: Information Disclosure Statement w/PTO/SB/08 (5 references)

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